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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,604	09/14/2000	Frank R. George	6421-A-1	8936

7590 07/15/2003

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[REDACTED] EXAMINER

NGO, HUNG V

ART UNIT	PAPER NUMBER
	2831

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/661,604</b>	Applicant(s) <b>George et al</b>
Examiner <b>Hung V. Ngo</b>	Art Unit <b>2831</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Apr 29, 2003

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-32 is/are pending in the application.

4a) Of the above, claim(s) 21-27 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-20 and 28-32 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

Newly submitted claims 21-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the cover can be used without transmitting RF energy from the treatment applicator through an area of the cover adjacent the tissue to be treated.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-27 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 1-3, 5-9, 14, 15, 17-20, 28, 29, 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Rodriguez.

Rodriguez discloses an apparatus having a front surface and a back surface (Fig 6), adhesive strip (38) or mean (38) for closing open end of said cover, tab (24) comprising fastener (Fig 3), opening (Fig 6)(re claims 1-3, 5-9, 14, 15, 17-20).

Rodriguez discloses an apparatus having a top side (16, 12) made of metal for preventing of RF energy (re claim 29) and a bottom side (14) made of a fabric for transmitting RF energy (Fig 5), an opening (the area between the top and bottom sides Fig 5), a closure means (18)(re claim 28, 31).

3. Claims 1, 4, 6, 12-14, 28-30, 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Cadwalader.

Cadwalader discloses an apparatus having a front surface and a back surface (Fig 1A), made of polyethylene (col 3, line 64) comprising means or tabs (18, 20).

4. Claims 1, 6, 7, 11, 15, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Tone et al

Tone et al discloses an apparatus having a front surface and a back surface and perforation (6).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez

The teaching of Rodriguez as discussed above does not disclose the opening having semicircular notch.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Rodriguez by employing the semicircular notch since more than a mere change of form is necessary for patentability. *In re Span-Deck Inc. v. Fab-Con, Inc.* (CA 8, 1982) 215 USPQ 835.

#### *Response to Arguments*

Applicant's arguments filed 04-29-03 have been fully considered but they are not persuasive.

Applicant argues (1) that Rodriguez article does not enclose a body and is not used for enclosing a treatment applicator, (2) that the shielding material forms a portion of the cover but not the whole cover and the article of Rodriguez is made of totally of electromagnetic non transmissive material. The examiner disagrees. With respect to (1) a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention

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and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). With respect to (2) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e.,the shielding material forms a portion of the cover but not the whole cover) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Communication*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung V. Ngo whose telephone number is (703) 308-7614. The examiner can normally be reached on Monday to Friday from 9:30 am to 06:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard, can be reached on (703) 308-3682.

The fax phone number for this Group is (703) 872-9318 (Before Final) or (703) 872-9319 (After Final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Hung V. Ngo

Hung V. Ngo

July 12, 2003

HUNG V. NGO  
PRIMARY EXAMINER